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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,725	09/21/2006	Joseph Jerome Leibenguth	09669/094001	2821
22511 7590 07/09/2010 OSHA LIANG L.L.P. TWO HOUSTON CENTER 909 FANNIN, SUITE 3500 HOUSTON, TX 77010				
EXAMINER TRAIL, ALLYSON NEEL				
ART UNIT 2876		PAPER NUMBER		
NOTIFICATION DATE 07/09/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
buta@oshaliang.com

### Office Action Summary

**Application No.**

10/593,725

**Applicant(s)**

LEIBENGUTH, JOSEPH JEROME

**Examiner**

ALLYSON N. TRAIL

**Art Unit**

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Amendment***

1. Receipt is acknowledged of the Amendment filed April 22, 2010.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishikawa (WO 2004/019261).

With respect to claim 1, page 23 discloses portable communication device (portable telephone) for at least mono-directional communication with a terminal (it is discussed on pages 1-4, how the SIM, which is held by a portable or mobile telephone, communicates either via contact or non-contact with various terminals such as credit card terminals, fuel pump terminals, etc. – also see page 15, line 30 – page 16, line 6), comprising: a micro-module 2 (page 23, lines 32-33 recite, “The SIM of the present invention can be used on a portable telephone”). The micro-module 2 is illustrated in

figure 1 and includes a chip 3 and an antenna 21, which allows the micro-module to communicate with the terminal when the antenna is placed in a vicinity of the terminal. The last paragraph of page 23 further discusses the communication between the SIM and the portable device (telephone) - the SIM communicates with a portable telephone through contact terminals. When the SIM is in the telephone, the SIM's antenna is held by the reader. Lastly, page 24 discloses that the micro-module (SIM) is removable.

With respect to claim 2, figure 10 illustrates the micro-module includes an external authentication marking element.

With respect to claim 3, it is discussed above that the SIM is inserted into a mobile telephone, which comprises a display and a keypad configured to interact with the chip.

With respect to claim 4, page 6, lines 5-16 and page 7, lines 7-12, discloses the reader comprises a USB connector configured to connect contacts of the micro-module to an external appliance.

With respect to claim 5, Nishikawa teaches throughout the disclosure communicating without contact.

With respect to claim 6, Nishikawa illustrates the reader further including memory component.

With respect to claims 7 and 8, Nishikawa teaches on page 4, the portable device of claim 5, wherein the block for communication of type 14443 types A and B as well as both low range and medium range type.

With respect to claims 11-19, Nishikawa teaches the portable device being a mobile telephone, therefore the device includes an audio/visual man/machine interface configured to transmit a signal in response to establishment of communication with an external appliance, a LED (light-emitting diode), a micro-buzzer, a vibrator, a display, an independent source of electrical energy rechargeable by an energy transfer device without galvanic contact, 16, the independent source of electrical energy uses magnetic induction as a medium for transferring energy, the independent source of electrical energy uses light as a medium for transferring energy and photovoltaic cells for converting energy, the independent source of electrical energy uses an electromagnetic field as a medium for transferring energy and a second antenna as an energy conversion system. Lastly, the mobile phone would include a switch placed on the antenna wherein communication may be established only by activating the switch and the communication would be inactive and consumes substantially no energy before the device enters a field in an immediate vicinity of an external appliance.

### ***Response to Arguments***

5. Applicant's arguments have been fully considered but they are not persuasive. Applicants argue that two separate examples are used to reject the pending claims. As is shown above in the current Office action however, it is clear that the example of the SIM holder is not needed to make the rejection.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[allyson.trail@uspto.gov](mailto:allyson.trail@uspto.gov)].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35*

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*U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

/Allyson N. Trail/  
Allyson N. Trail  
Primary Examiner  
Art Unit 2876

July 2, 2010